

REMARKS**Status of Claims**

The Office Action mailed January 24, 2005 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-36 were pending in the application. Claims 1, 2, 4-6, 8-14, 18-20, 22, 24-26, and 28-33 have been amended, claims 3, 7, 16, 17, 21, 23, 27, and 34-36 have been canceled, and no claims have been newly added. Therefore, claims 1, 2, 4-6, 8-15, 18-20, 22, 24-26, and 28-33 are pending in the application.

This amendment changes and cancels claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Rejection under 35 U.S.C. §112, Second Paragraph

Claims 5, 18, and 25 are rejected under 35 U.S.C. § 1.112, second paragraph, as being indefinite. In reply, applicant has amended these claims to address the issue raised in the office action and submit that these claims are now in definite form and meet the requirements of §112, second paragraph.

Rejection under 35 U.S.C. § 101

In the Office Action, claims 20-33 are rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. In reply, applicant has amended these claims in the manner suggested by the examiner to overcome this rejection. Furthermore, applicant notes that the original claims were directed to a computer program *product* and not to a computer program per se as stated in the office action. Such computer program *product* claims are considered equivalent to the claims as presently amended and this format has been found to be statutory by the Federal Circuit since its decision in *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995).

Prior Art Rejections

Claims 1, 3-14, 16-20, 23-33, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over IBM Technical Disclosure Bulletin (hereafter "IBM Bulletin"). Claims 2, 15, 21, 22, 34, and 36 are rejected under 35 U.S.C. § 103(a) over IBM further in view of U.S. patent 6,393,442 to Cromarty et al. (hereafter "Cromarty"). Applicant respectfully traverses these rejections for at least the following reasons.

Each of the pending independent claims 1, 14, and 20 recite a computer implemented method (or system/computer program product) for storing and transmitting data across a global commerce network in which a document received in a first format is parsed into a node set of nodes with each node comprising an information couplet including a semantic tag and a value. The nodes in the node set are indexed and stored in a data store so that selected nodes from the node set can be retrieved and reassembled for transmitting in a second format across the global commerce network. Furthermore, these claims recite automatically triggering propagation of a predetermined event on the node set (for example, a new node set or update of an existing node set) across the global commerce network to a registered partner.

At least this recited feature is not disclosed or suggested by the applied prior art. Specifically, the IBM Bulletin only discloses that certain tags of a style of a document are mapped to the nodes of a schema to facilitate searching and formatting of the document. See page 2 of the IBM bulletin. There is simply no teaching or suggestion of the claimed automatically triggering propagation of a predetermined event across the global commerce network to a registered partner. With respect to this feature, the office action states (with respect to the original claim 7) that this claim language reads on the "appending of the tag to the indexed tree used to store the data described in IBM..." However, how this reads on the claim language is unclear to the applicant. For example, (1) what is automatically triggered, (2) what is propagated, (3) what is the predetermined event on the node set (presumably this corresponds to the appending of the tag to the indexed tree), and (4) and what is propagated across the global commerce network to a registered trading partner.

These deficiencies in the IBM Bulletin are not cured by any of the other applied references. Therefore, the office action fails to make a *prima facie* case of obviousness with respect to the pending claims.

It should be noted that the Patent Office (PTO) has the burden of proving each of the claimed features is shown by the prior art. An allegation that claimed subject matter is "obvious" (as here alleged) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO's review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966). Likewise, any allegations of inherency requires that the alleged feature be *necessarily* present in the reference.

The dependent claims are also patentable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional reasons for their patentability when considered as a whole.

Conclusion

In view of the above, applicant believes that the present application is now in condition for allowance. An early notice of the same is respectfully solicited. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicant hereby petitions for any needed extension of time.

Respectfully submitted,

Date April 13, 2005

FOLEY & LARDNER LLP

Customer Number: 22428

Telephone: (202) 672-5485

Facsimile: (202) 672-5399

By Aaron C. Chatterjee
William T. Ellis
Registration No. 26,874
Aaron C. Chatterjee
Registration No. 41,398
Attorneys for Applicant